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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,655	12/17/2001	Errol D'Souza	4665/8	1879

26291 7590 05/03/2005

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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/022,655	D'SOUZA ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-21,24,25,27,29,31,33 and 35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-21,24,25,27,29,31,33 and 35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 December 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The amendment filed 11 April 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is directed towards the modification of the particular embodiment illustrated in Figure 4 so as to particularly include an "aging process" where such is necessarily included in that embodiment and is performed at that particular point in the process flow.

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

2. The drawings were received on 11 April 2005. These drawings are not approved due to the presence of new matter.

Response to Arguments

3. Applicant's arguments filed 11 April 2005 have been fully considered but they are not persuasive.

With respect to the rejection of claims 5, 18, 19, and 20 under 35 U.S.C. 112, first paragraph, the applicant argues that a proper prima facie case has not been established pertaining to the lack of enablement in view of the disclosure as originally filled as it would be clear to one having ordinary skill in the pertinent technology as to how the aging process

would be used in the process of automatically flagging favorite channels. The examiner respectfully disagrees. The instant application as originally filled only makes reference to the particular usage of an aging process in the "Brief Summary of Invention" in connection with "other embodiments". Neither the provisional application, nor the claims as originally filled disclose the usage of an aging algorithm in connection with the illustrated embodiments of Figures 3-5 as originally filled. The aging process was added into the claim in combination with the other claimed elements during the course of the prosecution of the application. The examiner does not refute that the support for an aging process exists in the specification, however what is non-enabling is how to necessarily utilize such in connection with or in combination with what is disclosed as other separate embodiments. The instant application simply does not set forth or disclose the particular usage of the aging algorithm in combination with the particular monitoring technique and the generation of a list of favorite channels as claimed in combination. Nor does the instant application reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of these particular combination of elements in a given embodiment.

As to the applicant's remarks 3, 4, 6-17, 21, 24, 25, 27, 29, 31, 33, and 35, such remarks are acknowledged however are moot in view of the lack of support / enablement of the independent claims.

With respect to the rejection of record based upon Candelore, the applicant argues that the reference teaches away from the claimed invention due to its usage of relative statistics as opposed to the claimed invention usage of "actual or true counts". The examiner respectfully disagrees. In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies (i.e., actual or true counts) are not recited in the rejected claim(s). The claim only requires for the particular usage of a "tune count indicator" for which the argued relative statistics represent. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Assuming arguendo, that the usage of "actual or true counts" is needed by the claim, then the reference would still meet such a limitation given that "actual or true counts" are utilized by the system prior to a rollover condition being encountered.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In particular, the Candelore reference discloses a system and method for developing a list of favorite channels and the Bates reference is relied upon for teaching the usage of aging in connection with maintaining a list of favorites. Accordingly, the particular modification to Candelore so as to further utilize an aging algorithm advantageously provides a means to emphasize programs/channels that have been watched more recently than others as taught by Bates.

In response to applicant's argument that the references fail to show certain features of applicant's invention pursuant to Ohkura, as was previously set forth in the examiner's earlier response, it is noted that the features upon which applicant relies (i.e., checking an entry already on the list to determine whether its viewing time is of a short duration) are not

recited in the rejected claim(s) nor is it clear that the specification supports such a limitation. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's remarks regarding the Noguchi, McClard, and Florence references are acknowledged and appear to be premised upon previously argued limitations derived from the independent claims not being taught. Accordingly, the examiner respectfully refers the applicant back to his earlier remarks.

Priority

4. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 3-21, 24, 25, 27, 29, 31, 33, and 35 of this application. In particular, the examiner is unable to find support within the earlier filling for the particular usage of aging favorite channel lists as claimed. Accordingly, the application is being examined on the basis of its filling date or 17 December 2001.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 3-21, 24, 25, 27, 29, 31, 33, and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification as originally filled describes the claimed "aging process" describes as a distinct embodiment of the invention (IA: Page 4, Lines 7-13), however, it does not provide enabling support as to how the aging process is actually utilized in combination with the other disclosed and/or claimed embodiments, nor does it reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of these particular combination of embodiments. For example, the invention discloses that "one embodiment" is utilized for monitoring commands (IA: Page 3, Line 19 – Page 4, Line 2), but that "other embodiments" provide an aging mechanism. Similarly, the embodiments of Figures 3-5, do not appear to utilize the aging process.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent

any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 3-8, 18-21, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US Pub No. 2002/0104081), in view of Bates et al. (US Pat No. 6,721,953).

In consideration of claims 5, 18, and 19, Candelore et al. discloses a method implemented via a system with corresponding hardware based "means" and/or software or computer readable media comprising program code (Page 4, Para. 41) for "automatically flagging one or more tunable channels broadcast over a distribution network as a favorite channel" (Page 1, Para. 18) wherein the "list of automatic favorite channels" is associated in memory with both the "identifier" as well as the "indicator" (Page 3, Para. 32).

As illustrated in Figure 5, the system is operable to "monitor commands input by the user" from an "input device" [5] including "command from the user to tune a channel" [402]. The system subsequently "records an identifier for the channel" [406] and may "increment a channel tune count indicator for the channel" (Table 5; Page 3, Para 30; Page 5, Paras. 48-51). This information is subsequently utilized to "select identifiers with the top indicators" for inclusion within the "list of automatic favorite channels" [408] (Figure 5; Page 4, Para. 47) displayed to the user.

With respect to the "determining" and "removing" steps, the reference teaches that the particular list may comprise a list of the top 15 channels that have the highest count value in the stat table (Page 4, Para 38). In order to implement the automatic process for developing

such a list, the system "determines whether the channel tune count indicator associated with a channel in the list of automatic favorite channels falls below a view threshold value" and subsequently "removes from the list of automatic favorite channels any identifier whose associated channel tune count indicator falls below the view threshold" wherein the "view threshold value" is defined as the "channel tune count" associated with the 11^{th} or 16^{th} channel (ex. the tenth indicator in the top ten indicators) in order to maintain a current list of favorite channels. For example, the reference discloses that the system may start with the first 10 channels and sort them by time wherein the channel with the lowest amount of time is replaced (thereby removing subsequent to a determination of a channel in the list that falls below a view threshold value associated with the Nth channel) with new ones using statistics stored in the stat tables [406] (Page 4, Para 47).

While the Candelore et al. reference discloses a technique for automatically decrementing the associated channel tune count indicator for any identifier in the list of automatic favorite channels (Page 5, Paras. 48-51) such is not performed in conjunction with an aging algorithm as claimed. In a related art pertaining to the development of favorite channel lists, the Bates et al. reference discloses that it is known in the art in connection with managing a list of favorite channels to "age the list of automatic favorite channels by automatically decrementing the associated channel tune count indicator for any identifier in the list of automatic favorite channels when the channel tune count indicator for a channel associated with the identifier is not incremented within a time period that exceeds a predetermined period" (Bates et al.: Figure 6; Col 8, Lines 27-33; Col 13, Lines 34-37). Accordingly, it would have been obvious to one having ordinary skill in the art to modify Candelore et al. so

as to further "age the list of automatic favorites" as taught by Bates et al. for the purpose of providing a means so as to advantageously emphasize programs/channels that have been watched more recently than others (Bates et al.: Col 8, Lines 29-32).

Claim 3 is rejected wherein Candelore et al. discloses that the system "records the amount of time that the channel was viewed" (Tables 1-3) and uses this information to "select identifiers with the top indicators and view times for inclusion within the list of automatic favorite channels" (Page 3, Para. 30; Page 4, Para. 45).

In consideration of claim 4, Candelore et al. discloses that the system is operable to create the list of favorites [408] based on "comparing the channel tune count indicator associated with a particular identifier with channel tune count indicators in the list of automatic favorite channels" in order to "determine if the indicator is greater than any indicator comprising the list". The system subsequently "adds the particular identifier and the associated indicator to the list" if it is "greater than any other channel tune count indicator comprising the list" (Page 4, Para. 47).

Claim 6 is rejected wherein the "step of selecting" further includes determining whether the "channel tune count indicator associated with a channel exceeds the view threshold value" wherein the "view threshold value being related substantially to an Nth highest channel tune count indicator" (Candelore et al.: Page 4, Para. 38).

In consideration of claim 7, Candelore et al. discloses that the system is operable to enable the user to establish user settings/preferences for the system (Page 2, Para. 27). The reference further suggests that the system provides flexibility with respect to the user being operable to change the criteria upon which the favorite channels are based (Page 3, Para. 30).

The reference, however, does not explicitly disclose nor preclude that the viewer may further related substantially to a "user defined value" such that the user may determine to only view the top 10 or top 15 channels referenced in conjunction with various examples disclosed. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify the invention if necessary, so as to provide the user with the ability to define the particular number of favorite channels (ex. 10 or 15) to display for the purpose of providing the user with the added flexibility to established their preferences for the particular number of favorite channels to be displayed. For example, if a system only comprises 10 channels, the particular display of all 10 channels as "favorites" would not be particularly useful.

In consideration of claim 8, the Candelore et al. reference does not explicitly disclose or preclude that the aforementioned "view threshold value" is a "value set dynamically by a content service provider". It would have been an obvious matter of design choice to enable the system to set the "value" dynamically by a content service provider, since applicant has not disclosed that the particular dynamic setting of the value by a remote content service provider solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the particular value being set by the user. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to establish the "view threshold value" via the service provider for the purposes of simplifying the operation of the system such that the user need not specify the particular number of favorite channels to display.

Alternatively, as taken as an admission of fact, it is notoriously well known in the art for a service provider to periodically distribute software to set top terminal units in order to update operating parameters. Accordingly, it would have been obvious to one having ordinary skill in the art to modify the Candelore et al. embodiment, if necessary, to facilitate the updating of set top terminal software for the purpose of advantageously allowing the "content service provider" with the ability to customize and update the user's interface remotely. Furthermore, in conjunction with the remote updating process of the user interface, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further enable the updating of a "threshold value" that determines the number of favorite channels to be displayed for the purpose of customizing the user interface menu format to display a particular number of favorite channels remotely.

Claim 20 is rejected wherein the aforementioned system [400] comprises a "channel list and view count data structure comprising a listing of channels viewed by a user and the number of times each channel has been tuned" [406]. The Candelore et al. system further comprises "favorite selection software" (Table 5; Page 3, Para 30; Page 4, Para 41; Page 5, Paras. 48-51) to "record an identifier for a channel", to "increment and decrement a channel tune count indicator for the channel according to prescribed criteria" (Page 5, Paras. 48-51), and to further "select recorded identifiers with the top indicators for inclusion within a list of automatic favorite channels" [408] (Page 4, Paras. 44-47).

With respect to the amended "removing" step, the reference teaches that the particular list may comprise a list of the top 15 channels which have the highest count value in the stat table (Page 4, Para 38). For example, the reference discloses that the embodiment may start

with the first 10 channels and sort them by time wherein the channel with the lowest amount of time is replaced with the with new ones that it finds with more time using statistics stored in the stat tables [406] (Page 4, Para 47). Accordingly, it would have obvious to perform an analogous operation so as to "remove from the list of automatic favorite channels any identifier whose associated channel tune count indicator falls below a view threshold value" such that the "view threshold value" is defined as the "channel tune count" associated with the 11th or 16th channel for the purpose of for the purpose of enabling the list of favorites to change accordingly to viewing habits when creating a top 10 or 15 channel list based on the number of times a channel has been accessed (Page 3, Para. 30).

As aforementioned, the Candelore et al. reference does not utilize an aging algorithm as particularly claimed. The Bates et al. reference discloses a technique for generating and managing a list of favorite channels that further "ages the list of automatic favorite channels by automatically decrementing the associated channel tune count indicator for any identifier in the list of automatic favorite channels when the channel tune count indicator for a channel associated with the any identifier is not incremented within a time period that exceeds a predetermined period" (Bates et al.: Figure 6; Col 8, Lines 27-33; Col 13, Lines 34-37). Accordingly, it would have been obvious to one having ordinary skill in the art to modify Candelore et al. so as to further "age the list of automatic favorites" as taught by Bates et al. for the purpose of providing a means so as to emphasize programs/channels that have been watched more recently than others (Bates et al.: Col 8, Lines 29-32).

Claim 21 is rejected wherein the "data structure and software" are stored on a "memory" [404] of a set top terminal [2] connected to the "distribution network" [3].

In consideration of claim 27, the Bates et al. reference discloses that older entries associated with the determination of favorite programs are decremented. However, the reference does not explicitly set forth the time based criteria or "predetermined period" that must pass prior to being deemed as "older". It would have been an obvious matter of design choice to use a "predetermined period" of "one 24-hour period", since the applicant has not disclosed that the particular duration of the period solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a shorter or longer "predetermined period". Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to utilize a "one 24-hour period" for the purpose of utilizing a particular timeframe criteria by which channel selection records may be designated as being older for the purpose of aging such that programs/channels that have been watched more recently (ex. within the last day) may be emphasized over those less recently watched.

10. Claims 9-14, 29, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US Pub No. 2002/0104081), in view of Bates et al. (US Pat No. 6,721,953), and in further view of Ohkura et al. (US Pat No. 5,737,029).

In consideration of claim 9, as aforementioned, the Candelore et al. reference discloses that it is operable to "record the identifier and increment the associated channel tune count" (Page 3, Paras. 31-32; Page 5, Paras. 48-51), however, it is unclear if the Candelore et al. system further utilizes a means such that channels are only recorded/incremented if viewed for a minimum duration. The reference suggests the usage of a minimum time interval (ex. 5 minutes), however, it does not clearly describe it in association with the recording of an

identifier. The Ohkura et al. reference discloses a method for determining favorite channels that is operable to "compare a duration that the channel is viewed for against a time threshold" such as 5 minutes wherein the identifier is only "recorded" if the "viewed for a duration greater than the time threshold" (Col 8, Lines 22-27). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Candelore et al., if necessary, so as to only "increment the associated channel tune count indicator" based on a time threshold as disclosed by Ohkura et al. for the purpose of advantageously to avoid the counting of broadcasting channels that are received for a short duration (Ohkura et al.: Col 8, Lines 22-27).

In consideration of claim 10, the Candelore et al. reference discloses that the system is operable to "receive indication of a selection of a favorite control on the input device" (Figure 3) so as to activate the list of favorite channels. Furthermore, the reference discloses that the system utilizes the input device [5] direction keys so as to traverse an EPG (Page 3, Para. 29). The reference, however, does not explicitly disclose that the user may utilize the aforementioned to "traverse the list of automatic channels". The commonly assigned Ohkura et al. reference discloses an EPG wherein the embodiment may "receive indication of a selection" of a "favorite control" [160] on the "input device" [50] in order to "traverse the list of automatic favorite channels" (Col 11, Lines 19-28). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the Candelore et al. system to utilize the channel selection techniques of Ohkura et al. for the purpose of improving the operability of channel selection so that the user can choose an intended broadcasting channel swiftly (Col 1, Lines 46 – Col 2, Line 40).

Claim 11 is rejected wherein the "list of automatic favorite channels" (Figures 16-21) may be "traversed one channel for each time the favorite control is selected" (Figure 15; Col 10, Lines 24-46)

Claim 12 is rejected wherein the "list of automatic favorite channels" may be "traversed . . . in order according to a rank of the channels in the list of automatic favorites" using the up-down "favorite control" [160].

In consideration of claim 13, the Candelore et al. reference discloses that the system is operable to "display an electronic program guide" and to further "retrieve the list of automatic favorite channels" in conjunction with the guide (Page 2, Para. 20). The reference, however, does not explicitly disclose nor preclude the particular composition of the guide such that the "scope of information presented by the electronic program guide" is limited to programming available on channels comprising the list of automatic favorite channels". As illustrated in Figures 16-21 of the Ohkura et al. embodiment may "display an electronic program guide" that is "limited" to "programming available on channels" of the "retrieved . . . list of the automatic favorite channels." Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Candelore et al. EPG so as to "limit" the guide display to programming associated with the list of automatic favorite channels as illustrated in Ohkura et al. for the purpose of improving the operability of channel selection so that the user can choose an intended broadcasting channel swiftly given that only programming associated with the favorite channels is displayed (Ohkura et al.: Col 1, Lines 46 – Col 2, Line 40).

Claim 14 is rejected wherein the system is operable to "receive" and "extract programming information" or "guide data" for "presentation within the electronic programming guide" (Ohkura et al.: Col 5, Lines 9-19; Col 8, Lines 4-6).

In consideration of claims 29, 31, and 33, the Bates et al. reference discloses that older entries associated with the determination of favorite programs are decremented. However, the reference does not explicitly set forth the time based criteria or "predetermined period" that must pass prior to being deemed as "older". It would have been an obvious matter of design choice to use a "predetermined period" of "one 24-hour period", since the applicant has not disclosed that the particular duration of the period solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a shorter or longer "predetermined period". Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to utilize a "one 24-hour period" for the purpose of utilizing a particular timeframe criteria by which channel selection records may be designated as being older for the purpose of aging such that programs/channels that have been watched more recently (ex. within the last day) may be emphasized over those less recently watched.

11. Claims 13, 15, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US Pub No. 2002/0104081), in view of Bates et al. (US Pat No. 6,721,953), in view of Noguchi et al. (US Pat No. 6,034,677).

In consideration of claim 13, the Candelore et al. reference discloses that the system is operable to "display an electronic program guide" [4A] and to further "retrieve the list of automatic favorite channels" (Page 2, Para. 20). The reference, however, does not explicitly

disclose nor preclude that the composition or nature of the EPG. Furthermore, the reference does not explicitly disclose that the information is necessarily "limited" in scope to "presenting the programming available on channels comprising the list of automatic channels".

The Noguchi et al. discloses a method and apparatus for displaying programming information in the form of an "electronic program guide" (Figure 13). Among its other features, the reference discloses that the guide may facilitate the user in designating certain programs as favorite programs. The reference, however, does not explicitly disclose nor preclude that this designation is a manual or automatic process or does it provide details pertaining to implementation of such an automated process. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Noguchi et al. favorite channel designation method to utilize the automatic flagging favorite channel teachings of Candelore et al. for the purpose of presenting the viewer with a selection of favorites based on a number of criteria without having to program manually the list of favorites (Candelore et al.: Page 1, Para. 18). Furthermore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Noguchi et al. reference to include a "Favorites" category for the purpose of facilitating the finding and selection of programming associated with favorite channels (Candelore et al. Page 1, Para. 3).

In consideration of claim 15, as illustrated in Figure 13, the program guide comprises a "full screen program guide comprising listings of programs available on the distribution network" (Noguchi et al.: Col 9, Lines 6-18).

Claim 16 is rejected wherein as illustrated in Figures 10-13, the full screen program guide [1301] comprises "audio and video associated with the channel viewed before the guide is displayed" (Noguchi et al.: Col 8, Line 25 – Col 9, Line 8).

Claim 25 is rejected wherein the system "includes the step of causing an icon to be displayed when a channel being viewed is on the list of automatic favorite channels" [2314] (Noguchi et al.: Figure 23; Col 15, Lines 5-9).

12. Claims 17 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US Pub No. 2002/0104081), in view of Bates et al. (US Pat No. 6,721,953), and in further view of McClard (US Pat No. 6,438,752).

In consideration of claim 17, the Candelore et al. reference discloses a scenario wherein the system is operable to "determine a time of day and a day of the week" and "based upon the day and time" select the "identifier" with the top indicator (Page 5, Para. 55). The system is operable to "select identifiers with the top indicators for inclusion within a list of automatic favorite channels" based on one or more items according to user preferences (Page 2, Para. 28; Page 3, Para. 30). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system, if necessary, to provide an automatic list [408] using two or more identifiers such as "time of day and a day of the week" for the purpose of advantageously assisting the user in selecting favorite programming options that are relevant to current time period. For example, while it might be interesting to learn that "Green Acres" is a favorite program, the information is not particularly helpful/useful if the program is not currently being aired.

Assuming arguendo, the McClard reference explicitly discloses a method to "select identifiers with the top indicators for inclusion within a time specific list of automatic favorite channels" (Col 6, 6, Lines 16-61). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Candelore et al. reference, if necessary, so as to generate a "time specific list of automatic favorite channels" as taught by McClard for the purpose of providing a system which allows each individual user to quickly and easily browse through programs of particular interest regardless of the time of day or week (McClard: Col 2, Lines 4-7).

In consideration of claim 35, the Bates et al. reference discloses that older entries associated with the determination of favorite programs are decremented. However, the reference does not explicitly set forth the time based criteria or "predetermined period" that must pass prior to being deemed as "older". It would have been an obvious matter of design choice to use a "predetermined period" of "one 24-hour period", since the applicant has not disclosed that the particular duration of the period solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a shorter or longer "predetermined period". Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to utilize a "one 24-hour period" for the purpose of utilizing a particular timeframe criteria by which channel selection records may be designated as being older for the purpose of aging such that programs/channels that have been watched more recently (ex. within the last day) may be emphasized over those less recently watched.

13. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US Pub No. 2002/0104081), in view of Bates et al. (US Pat No. 6,721,953), in further view of Florence (US Pub No. 2002/0188948).

In consideration of claim 24, the Candelore et al. reference does not explicitly illustrate that the stat tables [406] further comprise "information conveying the particular channel and a service carried on that channel". The reference however, suggests that the stat tables [406] store statistics comprising any other item type in determining a list of favorites (Page 3, Para. 33). The Florence reference discloses the storing of an "identifier for a particular channel" that comprises "information conveying the particular channel and a service carried on that channel" such as a channel number and associated provider associated with that channel for use in determining a list of favorite channels (Figure 4B). Accordingly, it would have been obvious to one having ordinary skill in the art to modify the stat tables [406] to further comprise any other type of information in determining a list of favorite channels including information "conveying the particular channel and a service carried on that channel" as illustrated in Florence for the purpose of utilizing any other item type available in determining a list of favorites.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a

first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
April 20, 2005

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